

REMARKS

Before entry of this Amendment and Response, the status of the application according to the pending Office action is as follows:

- Claims 1-3, 6, 7, 15-21, and 32-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,148,953 to Horton (hereinafter “Horton”).
- Claims 4, 5, 8-14, and 22-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horton.
- Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,974,512.

Applicants hereby amend the specification to incorporate recitation of the priority application data for this case. No new matter is added thereby. The priority claim was made in the application as filed, at least in the Application Disclosure Sheet filed therewith. The Patent Office acknowledged the priority claim in the Filing Receipt dated November 3, 2005.

Applicants hereby amend claims 1, 12, and 19, without prejudice, and cancel claims 2-5, 10, 11, and 13 without prejudice. Support for the amended claims can be found in the application as filed, at least at paragraphs [0009] and [0054], FIG. 10B, and claims 1 and 5. No new matter is added thereby.

With this Amendment and Response, Applicants respectfully submit that amended independent claims 1 and 19 are now in condition for allowance. Claims 6-9, 12, 14-18, and 20-34 depend, either directly or indirectly from amended independent claims 1 and 19, and include all the respective limitations thereof. Applicants respectfully submit that those claims are patentable as well. Allowance of claims 1, 6-9, 12, and 14-34 is respectfully requested.

1. Claims 1-3, 6, 7, 15-21, and 32-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Horton. Applicants respectfully traverse the rejection, as applied to the claims, as amended.

As an initial matter, independent claim 1 has been amended to incorporate the limitations of dependent claim 5. Applicants note that claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Horton. Applicants will address the § 103(a) rejection in the following section. Claims 2 and 3 have been cancelled, rendering the rejection moot with regard to these claims.

Horton appears to disclose a weatherstrip which has a backing strip on which is attached two longitudinal rows of pile. Horton, Abstract. To manufacture the weatherstrip, Horton appears to disclose locating stripper wires 12 on opposite sides of a band 10 offset from the center. Col. 3, ln. 15. Horton further discloses a membrane strip 16 having a width of “less than twice the width of a side of the band 10 so as to provide surface area around the edges of the band 10.” Col. 3, ln. 25-26. Fibers, in the form of yarn 18, are wound around the band 10 and over the membrane 16. Col. 3, ln. 27-29. Further along the travel of the band 10, backing strips 22 are fed on to the edges of the band 10. Col. 3, ln. 48-49. The membrane strip 16 and the yarn 18 are then welded to the backing strip 22, and then the welded weatherstrips are fed between slitter wheels 32, which slit through the yarn 18. Col. 3, ln. 58-66.

In contrast, Applicants claim, in amended claim 1, “wrapping a fin material longitudinally around” a traveling band “such that respective edges of the fin material overlap.” Applicants respectfully submit that Horton fails to teach or suggest “wrapping a fin material longitudinally around” a traveling band “such that respective edges of the fin material overlap.” Instead Horton appears to disclose wrapping a fin material around a traveling band, with no fin

material overlapping. *See* Horton, FIG. 2. In fact, it appears that it would be impossible to overlap the edges of the membrane strip disclosed in Horton, since “the width of the membrane strip 16 is less than twice the width of a side of the band.” Col. 3, ln. 23-25. Clearly, overlapping the edges of the membrane strip would only be possible if the strip was wide enough to wrap more than completely around the band. Horton does not disclose a strip having such width. Accordingly, Applicants respectfully submit that Horton fails to anticipate amended claim 1.

Applicants claim, in amended independent claim 19, a winding station for winding a pile material around the fin material and the band, such that “the excess fin material is relative to the pile material proximate the at least one side of the traveling band.” Applicants respectfully submit that Horton fails to teach or suggest “the excess fin material is relative to the pile material proximate the at least one side of the traveling band.” Instead, Horton depicts the membrane strip 16 being the same height or less than the surrounding pile 34, 36. *See* Horton, FIGS. 2, 3, and 5. Accordingly, there is no “excess fin material” as claimed by Applicants. Horton specifically notes that the fin material is “co-terminous with the ends of the pile 34 and 36.” Col. 4, ln. 18-19. There is no “excess fin material relative to the pile material proximate the at least one side of the traveling band,” and Horton fails to anticipate amended claim 19.

Therefore, Horton does not teach or describe each and every element of independent claims 1 and 19 as amended. Accordingly, the rejections of claims 6, 7, 15-18, and 32-34 which depend therefrom are also overcome. Withdrawal of the rejection of claims 1-3, 6, 7, 15-21, and 32-34 under 35 U.S.C. § 102(b) as being anticipated by Horton is respectfully requested.

2. Claims 4, 5, 8-14 and 22-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horton. Applicants respectfully traverse the rejection as applied to the claims, as amended.

Horton is described above. Claims 4, 5, 10, 11, and 13 have been cancelled, thus rendering the rejection moot with regard to those claims.

With regard to amended claim 1, which now incorporates the subject matter of dependent claim 5, Applicants claim a method of manufacturing a weatherstrip, including “wrapping a fin material longitudinally around” a traveling band “such that respective edges of the fin material overlap.” As indicated above, Horton fails to teach or suggest “wrapping a fin material longitudinally around” a traveling band “such that respective edges of the fin material overlap.” The limitation of “wrapping a fin material longitudinally around” a traveling band “such that respective edges of the fin material overlap” is not obvious in light of Horton, as Horton appears to be directed to a weatherstrip that utilizes a membrane strip having a width is less than twice the width of a side of the band. Horton, col. 3, ln. 23-25. Horton does not teach or suggest the use of wider membrane strips to allow for overlap of the edges thereof.

Additionally, the Office action states that “overlapping edges of the membrane or fin material is well known and conventional in the art.” As an initial matter, it appears that the Office action is relying on common knowledge or Official Notice to reject the claim. Applicants respectfully submit that the statement that the limitation is “well known and conventional in the art,” is improper, as it does not comply with the procedure outlined in the Manual of Patent Examination Procedures (MPEP) for relying on common knowledge or the taking of Official Notice. *See* MPEP 2144.03. To the extent that the Office action is not relying on common knowledge or Official Notice, Applicants respectfully request that the next Office action include a reference identifying the claim limitation that is indicated as being “well-known and conventional.”

The MPEP provides that “it would *not* be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03(A) (emphasis in original). Applicants respectfully submit that the benefits of overlapping the edges of fin material in a weatherstrip is not capable of such instant and unquestionable demonstration, as discussed in more detail below.

The MPEP further requires that if Official Notice is taken, the basis for such reasoning must be set forth explicitly. MPEP 2144.03(B). In fact, the Examiner “must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” *Id.* (emphasis added). For support, the Office action states that “overlapping edges of the membrane or fin material is well known and conventional in the art . . . in order to provide the predictable result providing [*sic*] a stronger weatherstripping with more membrane material between the pile.” Applicants respectfully challenge this factual assertion and traverse. Applicants respectfully submit that this analysis is not technically sound, as “overlapping edges of the membrane or fin material” during manufacture according to Applicants’ described embodiment of the invention would not necessarily provide a stronger weatherstrip. To the contrary, while overlapping the fin material would create a weatherstrip with fin material extending above the pile, the height of the fin material would have little or no bearing on the strength of the weatherstrip. While making the fin thicker may make the fin material stronger (e.g., more resistant to fin tearing), making the fin higher may potentially increase the chance of damage to the fin.

The MPEP provides that “if applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the

rejection is to be maintained.” MPEP 2144.03(C). Accordingly, Applicants hereby request the next Office action include a reference or declaration supporting the finding, in accordance with 37 CFR § 1.104(d)(2). Applicants also request that the next action not be made final, and note that claim 1 was not technically “amended” in this response, but was instead amended to incorporate dependent claim limitations. *See* MPEP 2144.03(D).

Moreover, with regard to the rejection of claims 8, 9, 12, 14, 22, and 24-31, specifically, Applicants respectfully submit that the Office action fails to establish a *prima facie* case of obviousness. The Office action only appears to indicate that the claimed invention “is within the purview of one having ordinary skill in the art” or “appears to be in the realm of mechanical skill.” Applicants note that “[R]ejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP 2143.01(IV), *citing KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007). Applicants respectfully request the next Office action include articulated reasoning for the rejection of claims 8, 9, 12, 22, and 24-31, or a reference that supports the rejection.

As argued above, Horton does not anticipate independent claims 1 and 19, as amended. Since claims 8, 9, 12, 14 and 22-31 depend, either directly or indirectly, from claims 1 or 19, and include all the respective limitations thereof, Applicants respectfully submit that those claims are patentable as well. Withdrawal of the rejection of claims 8, 9, 12, 14 and 22-31 under 35 U.S.C. § 103(a) as being unpatentable in view of Horton is respectfully requested.

3. Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,974,512. With regard to claims 1, 6-9, 12, and 14-34, Applicants submit herewith a terminal disclaimer in compliance

with 37 C.F.R. § 1.321(c), disclaiming over U.S. Patent No. 6,974,512. A fee transmittal form and check are enclosed to cover the requisite fee.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection of claims 1, 6-9, 12, and 14-34, and passage of these claims to allowance. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

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